

10/787,440

JUL 29 2004 16:11 FR FINNEGAN HENDERSON 202 408 4400 TO 1011057250816*02 P.03

PATENT

Customer No. 22,852

Attorney Docket No. 05725.0816-02000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Veronique FERRARI et al.)
)
Application No.: Unassigned) Prior Group Art Unit: 1615
)
Filing Date: February 27, 2004) Prior Examiner: Unassigned
)
For: METHOD OF MAKING A MASCARA)
COMPOSITION COMPRISING A)
POLYAMIDE POLYMER AND AT)
LEAST ONE INERT FILLER (AS)
AMENDED)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

Assignee, L'Oréal S.A. ("Assignee"), duly organized under the laws of France and having its principal place of business at 14 Rue Royale, 75008 Paris, France, through its attorneys, represents that it is the assignee of the entire right, title, and interest in and to the instant Application, filed February 27, 2004, wherein the application number has not yet been assigned but which is a continuation of Application No. 10/203,018, filed August 5, 2002, in the names of Véronique FERRARI, Richard KOLODZIEJ, Carlos O. PINZON, and Paul THAU, for COMPOSITION COMPRISING AT LEAST ONE POLYMER CONTAINING HETERO-ATOMS AND AT LEAST ONE INERT FILLER AND METHODS FOR USE, by assignment duly recorded in the United States Patent and Trademark Office at Reel 014055, Frame 0428, on March 24, 2003.

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Assignee further represents that it is and at all times has been the assignee of the entire right, title and interest in and to the following U.S. patent applications and patents:

U.S. Patent Application No. 09/618,032, filed July 17, 2000, issued on June 11, 2002, as U.S. Patent No. 6,402,408, in the name of Véronique FERRARI, for COMPOSITION CONTAINING A LIQUID FATTY PHASE GELLED WITH A POLYAMIDE CONTAINING ESTER END GROUPS, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011057, Frame 0007, on September 12, 2000;

U.S. Patent Application No. 09/618,066, filed July 17, 2000, in the names of Véronique FERRARI and Pascal SIMON, for COMPOSITIONS IN RIGID FORM STRUCTURED WITH A POLYMER, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011057, Frame 0676, on September 11, 2000;

U.S. Patent Application No. 09/685,577, filed October 11, 2000, in the names of Véronique FERRARI and Pascal SIMON, for COMPOSITIONS IN RIGID FORM STRUCTURED WITH A POLYMER, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011455, Frame 0203, on January 22, 2001;

U.S. Patent Application No. 09/685,578, filed October 11, 2000, in the name of Véronique FERRARI, for COMPOSITION CONTAINING A LIQUID FATTY PHASE GELLED WITH A POLYAMIDE CONTAINING ESTER END GROUPS, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011549, Frame 0914, on February 20, 2001;

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U.S. Patent Application No. 09/733,896, filed December 12, 2000, in the names of Carlos O. PINZON and Paul THAU, for COMPOSITIONS CONTAINING HETEROPOLYMERS AND OIL-SOLUBLE POLYMERS AND METHODS OF USING SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011765, Frame 0183, on April 26, 2001;

U.S. Patent Application No. 09/733,897, filed December 12, 2000, in the names of Carlos O. PINZON and Paul THAU, for COMPOSITIONS CONTAINING HETEROPOLYMERS AND METHODS OF USING SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011646, Frame 0966, on April 4, 2001;

U.S. Patent Application No. 09/733,898, filed December 12, 2000, in the names of Carlos O. PINZON and Paul THAU, for COMPOSITIONS CONTAINING HETEROPOLYMERS AND OIL-SOLUBLE ESTERS AND METHODS OF USING SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011654, Frame 0869, on April 2, 2001;

U.S. Patent Application No. 09/733,899, filed December 12, 2000, in the names of Mohamed KANJI, Carl ORR, and Carlos O. PINZON, for COSMETIC COMPOSITIONS CONTAINING AT LEAST ONE HETERO POLYMER AND AT LEAST ONE FILM-FORMING SILICONE RESIN AND METHODS OF USING, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 011723, Frame 0503, on April 20, 2001;

U.S. Patent Application No. 09/733,900, filed December 12, 2000, in the names of Carlos O. PINZON and Paul THAU, for COSMETIC COMPOSITIONS CONTAINING

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HETEROPOLYMERS AND OIL-SOLUBLE CATIONIC SURFACTANTS AND
METHODS OF USING SAME, as indicated by assignment duly recorded in the U.S.
Patent and Trademark Office at Reel 011639, Frame 0897, on March 23, 2001;

U.S. Patent Application No. 09/749,036, filed December 28, 2000, in the names
of Véronique FERRARI and Véronique JACQUES, for COMPOSITION COMPRISING
AT LEAST ONE HETERO POLYMER AND AT LEAST ONE PASTY FATTY
SUBSTANCE AND METHODS FOR USE, as indicated by assignment duly recorded in
the U.S. Patent and Trademark Office at Reel 011723, Frame 0518, on April 20, 2001;

U.S. Patent Application No. 09/899,909, filed July 9, 2001, issued on August 13,
2002, as U.S. Patent No. 6,432,391, in the name of Isabelle BARA, for TRANSPARENT
SCENTED SOLID COSMETIC COMPOSITION, as indicated by assignment duly
recorded in the U.S. Patent and Trademark Office at Reel 012278, Frame 0077, on
October 23, 2001;

U.S. Patent Application No. 09/937,314, filed September 24, 2001, in the name
of Véronique FERRARI, for TRANSFER-RESISTANT COMPOSITION STRUCTURED
IN RIGID FORM BY A POLYMER, as indicated by the assignment duly recorded in the
U.S. Patent and Trademark Office at Reel 012476, Frame 0507, on January 17, 2002;

U.S. Patent Application No. 09/971,028, filed October 5, 2001, in the name of
Mohamed KANJI, for METHODS OF USE AND OF MAKING A MASCARA
COMPRISING AT LEAST ONE COLORING AGENT AND AT LEAST ONE
HETEROPOLYMER, as indicated by assignment duly recorded in the U.S. Patent and
Trademark Office at Reel 012411, Frame 0820, on December 28, 2001;

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U.S. Patent Application No. 10/012,029, filed December 11, 2001, in the name of Nathalie COLLIN, for COSMETIC COMPOSITION COMPRISING A POLYMER BLEND, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 013142, Frame 0645, on August 1, 2002;

U.S. Patent Application No. 10/012,051, filed December 11, 2001, in the name of Nathalie COLLIN, for USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN FIBERS, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 012847, Frame 0285, on April 30, 2002;

U.S. Patent Application No. 10/012,052, filed December 11, 2001, in the name of Nathalie COLLIN, for COSMETIC COMPOSITION CONTAINING A WAX AND A POLYMER, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 012847, Frame 0264, on April 30, 2002;

U.S. Patent Application No. 10/046,568, filed January 16, 2002, in the names of Xavier BLIN, Véronique FERRARI, and Frédéric AUGUSTE, for NAIL POLISH COMPOSITION COMPRISING A POLYMER, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 013109, Frame 0731, on July 18, 2002;

U.S. Patent Application No. 10/047,987, filed January 17, 2002, in the name of Véronique FERRARI, for COSMETIC COMPOSITION CONTAINING A POLYMER AND A FLUORO OIL, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 012910, Frame 0028, on May 17, 2002;

U.S. Patent Application No. 10/129,377, filed May 3, 2002, in the name of Véronique FERRARI, for COMPOSITION STRUCTURED WITH A POLYMER CONTAINING A HETEROATOM AND AN ORGANOGEELLATOR, as indicated by

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assignment filed October 16, 2002, and not yet recorded by the U.S. Patent and Trademark Office;

U.S. Patent Application No. 10/182,830, filed August 2, 2002, in the names of Roberto CAVAZZUTI, Véronique FERRARI, Brian MATTOX, Carlos O. PINZON, and Paul THAU, for COSMETIC COMPOSITION COMPRISING HETERO POLYMERS AND A SOLID SUBSTANCE AND METHOD OF USING SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 014040, Frame 0345, on May 7, 2003;

U.S. Patent Application No. 10/198,931, filed July 22, 2002, in the name of Mohamed KANJI, for COMPOSITIONS COMPRISING AT LEAST ONE HETEROPOLYMER AND FIBERS, AND METHODS OF USING THE SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 013410, Frame 0044, on October 21, 2002;

U.S. Patent Application No. 10/203,018, filed August 5, 2002, in the name of Véronique FERRARI, for COMPOSITION COMPRISING AT LEAST ONE POLYMER CONTAINING HETERO-ATOMS AND AT LEAST ONE INERT FILLER AND METHODS FOR USE, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 014055, Frame 0428, on March 24, 2003;

U.S. Patent Application No. 10/203,254, filed August 7, 2002, in the names of Véronique FERRARI, Carlos O. PINZON, and Paul THAU, for COSMETIC COMPOSITIONS CONTAINING AT LEAST ONE HETEROPOLYMER AND AT LEAST ONE GELLING AGENT AND METHODS OF USING THE SAME, as indicated by

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assignment duly recorded in the U.S. Patent and Trademark Office at Reel 013607,
Frame 0258, on December 20, 2002;

U.S. Patent Application No. 10/203,375, filed August 9, 2002, in the names of
Nathalie JAGER-LEZER and Jean-Christophe SIMON, for COLOURED
TRANSPARENT OR TRANSLUCENT COSMETIC COMPOSITION, as indicated by
assignment duly recorded in the U.S. Patent and Trademark Office at Reel 013318,
Frame 0962, on August 9, 2002;

U.S. Patent Application No. 10/203,374, filed August 9, 2002, in the names of
Jean-Christophe SIMON and Nathalie JAGER-LEZER, for METHOD FOR MAKING A
COLOURED MAKE-UP COSMETIC COMPOSITION WITH CONTROLLED
TRANSMITTANCE, as indicated by assignment duly recorded in the U.S. Patent and
Trademark Office at Reel 013321, Frame 0001, on August 9, 2002;

U.S. Patent Application No. 10/413,217, filed April 15, 2003, in the names of
Mohamed KANJI and Sue FENG, for METHODS OF DISPERSING AT LEAST ONE
COLORING AGENT USING AT LEAST ONE HETEROPOLYMER, as indicated by
assignment duly recorded in the U.S. Patent and Trademark Office at Reel 012411,
Frame 0820, on December 28, 2001, in the parent case, U.S. Patent Application No.
09/971,028, filed October 5, 2001, in the names of Mohamed KANJI and Sue FENG, for
METHODS OF DISPERSING AT LEAST ONE COLORING AGENT USING AT LEAST
ONE HETEROPOLYMER;

U.S. Patent Application No. 10/450,108, filed June 11, 2003, in the name of
Nathalie COLLIN, for COSMETIC COMPOSITION COMPRISING A POLYMER AND
FIBERS, for which the assignment has not yet been filed;

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U.S. Patent Application No. 10/466,166, filed July 14, 2003, in the name of Nathalie COLLIN, for COSMETIC COMPOSITION COMPRISING A MIXTURE OF POLYMERS, for which the assignment was filed on January 20, 2004, but has not yet been recorded by the U.S. Patent and Trademark Office;

U.S. Patent Application No. 10/459,636, filed on June 12, 2003, in the names of Shao Xiang LU and Mohamed KANJI, for COSMETIC EMULSIONS CONTAINING AT LEAST ONE HETEROPOLYMER AND A SUNSCREEN AND METHODS OF USING SAME, for which the assignment was filed on October 3, 2003, but has not yet been recorded by the U.S. Patent and Trademark Office;

U.S. Patent Application No. 10/618,315, filed on July 11, 2003, in the names of Shao Xiang LU, Terry VAN LIEW, and Nathalie GEFFROY-HYLAND, for COSMETIC COMPOSITIONS COMPRISING A STRUCTURING AGENT, SILICONE POWDER AND SWELLING AGENT, for which the assignments were filed on August 12, 2003, and January 30, 2004, but have not yet been recorded by the U.S. Patent and Trademark Office;

U.S. Patent Application No. 10/699,780, filed November 4, 2003, in the names of Sue FENG and Mohamed KANJI, for METHODS OF DISPERSING AT LEAST ONE COLORING AGENT USING AT LEAST ONE HETEROPOLYMER, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 012411, Frame 0820, on December 28, 2001, in the parent case, U.S. Patent Application No. 09/971,028, filed October 5, 2001, in the names of Mohamed KANJI and Sue FENG, for METHODS OF DISPERSING AT LEAST ONE COLORING AGENT USING AT LEAST ONE HETEROPOLYMER;

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U.S. Patent Application No. 10/746,612, filed December 22, 2003, in the names of Shao Xiang LU, Terry VAN LIEW, Nathalie GEFFROY-HYLAND, and Mohamed KANJI, for COSMETIC COMPOSITIONS COMPRISING A STRUCTURING AGENT, SILICONE POWDER AND SWELLING AGENT, for which the assignment information has not yet been filed;

U.S. Patent Application No. 10/747,412, filed December 22, 2003, in the names of Mohamed KANJI and Shao Xiang LU, for COSMETIC EMULSIONS CONTAINING AT LEAST ONE HETERO POLYMER AND AT LEAST ONE SUNSCREEN AND METHODS OF USING THE SAME, for which the assignment information has not yet been filed; and

the application filed on February 27, 2004 (Attorney Docket No. 05725.0795-02000), in the names of Roberto CAVAZZUTI, Véronique FERRARI, Brian MATTOX, Carlos O. PINZON, and Paul THAU, for COSMETIC COMPOSITION COMPRISING HETERO POLYMERS AND A SOLID SUBSTANCE AND METHOD OF USING SAME, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office at Reel 014040, Frame 0345 on May 7, 2003, in the parent case, U.S. Patent Application No. 10/182,830, filed August 2, 2002, in the names of Roberto CAVAZZUTI, Véronique FERRARI, Brian MATTOX, Carlos O. PINZON, and Paul THAU, for COSMETIC COMPOSITION COMPRISING HETERO POLYMERS AND A SOLID SUBSTANCE AND METHOD OF USING SAME.

To the extent that assignments have not yet been filed and/or recorded by the U.S. Patent and Trademark Office, the undersigned represents that the instant application and the referenced U.S. Application Nos. 10/459,636, 10/466,166,

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10/450,108, 10/618,315, 10/746,612, and 10/747,412 were, at the time the instant invention was made, owned by or subject to an obligation of assignment to a common assignee. See M.P.E.P. §§ 1490 and 706.02(I)(2)(II).

Evidentiary documents have been reviewed and, to the best of Assignee's knowledge and belief, title to both the instant application and each U.S. patent application and U.S. patent listed above is in the Assignee submitting this Terminal Disclaimer.

To obviate any potential double patenting rejection in the present application, Assignee hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173, as presently shortened by any terminal disclaimer, of the prior patents and/or any patent granted for any patent application listed above, Assignee hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any prior patents and/or any patent granted for any patent application listed above are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, Assignee does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of any prior patent and/or any patent granted for any patent application listed above, as presently shortened by any terminal disclaimer, in the event that any prior patent and/or any patent granted for any patent application listed above later expires for failure to pay a

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maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of their full statutory term as presently shortened by any terminal disclaimer.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$110.00 is being filed with this disclaimer.

If there are any additional fees due in connection with the filing of this Terminal Disclaimer, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to Deposit Account No. 06-0916.

The undersigned is an attorney of record.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2004

By: 

Thomas L. Irving
Reg. No. 28,619